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EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/732,791

Applicant(s)

YU ET AL.

Examiner

David Lazaro

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-83 are pending in this Office Action.

Priority

2. Receipt is acknowledged of papers ('089100848', 01/19/2000 and '089105612', 03/27/2000) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. Applicant is reminded of the proper content of an abstract of the disclosure.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: In the abstract, lines 6-7 and lines 14-16, "the invention can extends only to notify...". On page 7, lines 5-8 "the system having

assisting function", "may further comprises". On page 8 lines 5-20. Many of these errors relate to improper grammar and word usage that cause the clear and concise meaning to be lost.

6. The disclosure is objected to because of the following informalities: "electronic information" in line 7 should be "electronic mail information".

Appropriate correction is required.

Claim Objections

7. Claims 7, 36, 42, 52, 54, 55, 63, 64, 65 and 71 are objected to because of the following informalities:

- a. Claim 7, in line 3, "maid" should be "mail".
- b. Claim 36 and 64, "electronic identification" should be "electronic mail identification".
- c. Claim 42, in line 2, "transmission" should be "transmission signal".
- d. Claim 52 and 55, all instances of "said electronic mail" should be "said new electronic mail" for consistency and clarity.
- e. Claim 54, in line 4, "identification" should be "identification service".
- f. Claim 63 is missing "comprises".
- g. Claim 65, in line 1, "receiving" should be "receiving means".
- h. Claim 71, in line 4, "an receiving" should be "a receiving".

Please note there are may be other typographic errors and omissions that the examiner did not catch. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5, 20, 39, 40, 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1-5, 20, 39, 40, 42 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Specifically note lines 3-4 of Claim 1, lines 3-4 of Claim 2, lines 3-4 of Claim 3, line 3 of Claim 4, lines 3-4 of Claim 5, lines 1-2 of Claim 20, lines 4-5 of Claim 39, lines 1-2 of Claim 40, and lines 3-4 of Claim 42. Please note there may be other errors that were not caught.

11. Claim 4 recites the limitation "said connection" in line 2. There is insufficient antecedent basis for this limitation in the claim. Note: The examiner believes Claim 4 should be dependent on Claim 3 and will base further rejections on this interpretation.

12. Claims 61-63 and 69 all recite the limitation "said receiving terminal". There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 5, 6, 9-14, 20, 23, 24-29, 33, 34, 40, 43, 44-49, 52, 65, 53, 55-60 and 69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 5-10, 13, 14, 17-22, 23, 24, 13, 15, 17-22, 25, 29, 33, 34-39, and 48 of copending Application No. 09/712,957.

Although the conflicting claims are not identical, they are not patentably distinct from each other. The primary difference between Claim 1 of 09/712,957 and Claim 1 of the instant application is the receiving end/terminal is portable in 09/712,957. However, the receiving end/terminal of the instant application does not exclude a portable receiving end/terminal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the instant application such that receiving terminal is a portable electronic mail identification end receiver. One would be motivated to have this

Art Unit: 2155

as it would allow users to continue to receive electronic mail identifications even when they are out of the house or office.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to omit elements when the remaining elements perform as before. A person of ordinary skill could have arrived at the present claims by omitting certain elements of claim 1. See *In re Karlson* (CCPA) 136 USPQ 184, decided January 16, 1963 ("Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before").

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 2155

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16. Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33-38, 40-47, 50-58, 61-68 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,212,265 by Duphorne (Duphorne).

17. With respect to Claim 1, Duphorne teaches a method for actively providing users with the message of a new mail by an electronic mail provider (Col. 2 lines 18-22), said method comprising: creating an identification information of said new mail as detecting the appearance of said new mail (Col. 2 lines 21-35); transforming said identification information into a transmission signal (Col. 2 lines 21-35); and transferring said transmission signal to a receiving terminal (Col. 2 lines 21-35).

18. With respect to Claim 2, Duphorne teaches all the limitations of Claim 1 and further teaches automatically sending said receiving terminal said identification information of said new mail as soon as receiving a response from said receiving terminal (Col. 6 line 55 – Col. 7 line 11).

19. With respect to Claim 5, Duphorne teaches all the limitations of Claim 1 and further teaches said users receiving said new mail from said electronic mail provider through a telecommunication network as soon as said users receiving said identification information (Col. 11 lines 2-4).

20. With respect to Claim 6, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

Art Unit: 2155

21. With respect to Claim 7, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal further comprises advertisement information of said electronic mail provider (Col. 9 lines 31-67).

22. With respect to Claim 8, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by using an identification communication protocol for a caller terminal (Col. 6 lines 10-54).

23. With respect to Claim 9, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a message subject for said new mail (Col. 4 lines 65-67).

24. With respect to Claim 10, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a receiving date and a receiving time (Col. 4 lines 65-67).

25. With respect to Claim 11, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises an electronic mail address of a sender (Col. 8 lines 28-33).

26. With respect to Claim 12, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a name of said sender (Col. 8 lines 28-33).

27. With respect to Claim 15, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

28. With respect to Claim 16, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

29. With respect to Claim 18, Duphorne teaches all the limitations of Claim 1 and further teaches a filtering step prior to transferring said transmission signal, said filtering step is used for suspending said transmission signal corresponding with a plurality of set deletion conditions for said new mail (Col. 4 lines 44-47).

30. With respect to Claim 19, Duphorne teaches all the limitations of Claim 1 and further teaches further comprising a filtering step prior to transferring said transmission signal, said filtering step is used for transferring said transmission signal corresponding with a plurality of set permission conditions for said new mail (Col. 4 lines 44-47).

31. With respect to Claim 20, Duphorne teaches a method for users to obtain a message from a new electronic mail (Col. 2 lines 18-22), said method comprising: receiving a transmission signal actively transferred from an electronic mail provider through a receiving terminal (Col. 2 lines 21-35); and transforming said transmission signal into an identification information (Col. 8 lines 8-41), said identification information is related to said new electronic mail that is not yet received or read by said users (Col. 4 lines 10-31).

32. With respect to Claim 21, Duphorne teaches all the limitations of Claim 20 and further teaches automatically transferring a response from said receiving terminal to said electronic mail provider after receiving said transmission signal, and said step of automatically transferring used for requesting said electronic mail provider to

automatically transfer said identification information to said receiving terminal (Col. 6 line 55 – Col. 7 line 11).

33. With respect to Claim 22, Duphorne teaches all the limitations of Claim 20 and further teaches displaying said identification information for notifying said users (Col. 8 lines 24-33).

34. With respect to Claim 23, Duphorne teaches all the limitations of Claim 20 and further teaches receiving said electronic mail from said electronic mail provider through a telecommunication network after reading said identification information by said users (Col. 11 lines 2-4).

35. With respect to Claim 24, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a message subject for said electronic mail (Col. 8 lines 28-33).

36. With respect to Claim 25, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a receiving date and a receiving time (Col. 8 lines 28-33).

37. With respect to Claim 26, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises an electronic mail address of a sender. (Col. 8 lines 28-33).

38. With respect to Claim 27, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

39. With respect to Claim 30, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

40. With respect to Claim 31, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

41. With respect to Claim 33, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises an electronic mail identification phone (Col. 7 lines 11-26)

42. With respect to Claim 34, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises an electronic mail identification assistant device (Col. 7 lines 11-26).

43. With respect to Claim 35, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises a caller identification phone that has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

44. With respect to Claim 36, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises a caller identification assistant device that has electronic identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

45. With respect to Claim 37, Duphorne teaches all the limitations of Claim 20 and further teaches a filtering step prior to transferring said transmission signal, said filtering step is used for suspending said transmission signal corresponding with a plurality of set deletion conditions for said new mail (Col. 4 lines 44-47).

Art Unit: 2155

46. With respect to Claim 38, Duphorne teaches all the limitations of Claim 20 and further teaches further comprising a filtering step prior to transferring said transmission signal, said filtering step is used for transferring said transmission signal corresponding with a plurality of set permission conditions for said new mail (Col. 4 lines 44-47).

47. With respect to Claim 40, Duphorne teaches a system for a electronic mail provider to actively transferring an identification information of an electronic mail (Col. 2 lines 18-35), said system comprising: modulating means for transforming said identification information into a transmission signal (Col. 6 lines 44-56); and transferring means for transferring said transmission signal to a receiving terminal of a user (Col. 6 lines 44-56).

48. With respect to Claim 41, Duphorne teaches all the limitations of Claim 40 and further teaches a mail server which is set in said electronic mail provider, wherein said mail server is used for receiving and transferring said electronic mails (Col. 3 lines 60-66).

49. With respect to Claim 42, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transforms said identification information into said transmission and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

50. With respect to Claim 43, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

51. With respect to Claim 44, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67).

52. With respect to Claim 45, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

53. With respect to Claim 46, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

54. With respect to Claim 47, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

55. With respect to Claim 50, Duphorne teaches all the limitations of Claim 40 and further teaches a filtering device for suspending said transmission signal corresponding with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

56. With respect to Claim 51, Duphorne teaches all the limitations of Claim 40 and further teaches further teaches a filtering device for transferring said transmission signal corresponding with a plurality of set permission conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

57. With respect to Claim 52, Duphorne teaches a system for assisting a user to obtain a message of a new electronic mail (Col. 2 lines 18-35), said system comprising:

Art Unit: 2155

receiving means for receiving a transmission signals which is transferred from an electronic mail provider (Col. 7 lines 11-20); analyzing means for transforming said transmission signals into an identification information of said electronic mail (Col. 8 lines 8-28); and displaying means for displaying said identification information (Col. 7 lines 48-57).

58. With respect to Claim 53, Duphorne teaches all the limitations of Claim 52 and further teaches a storage device for storing said identification information (Col. 8 lines 15-20).

59. With respect to Claim 54, Duphorne teaches all the limitations of Claim 52 and further teaches said electronic mail provider translates said identification information and transfers said transmission signal by utilizing an communication protocol of identification by a caller terminal (Col. 6 lines 44-56).

60. With respect to Claim 55, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67).

61. With respect to Claim 56, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

62. With respect to Claim 57, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

Art Unit: 2155

63. With respect to Claim 58, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

64. With respect to Claim 61, Duphorne teaches all the limitations of Claim 52 and further teaches said receiving terminal comprises an electronic mail identification phone (Col. 7 lines 11-26)

65. With respect to Claim 62, Duphorne teaches all the limitations of Claim 52 and further teaches said receiving terminal comprises an electronic mail identification assistant device (Col. 7 lines 11-26).

66. With respect to Claim 63, Duphorne teaches all the limitations of Claim 52 and further teaches said receiving terminal an identification phone that has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

67. With respect to Claim 64, Duphorne teaches all the limitations of Claim 52 and further teaches said receiving terminal comprises a identification assistant device that has electronic identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

68. With respect to Claim 65, Duphorne teaches all the limitations of Claim 52 and further teaches said displaying means comprises a displaying plane (Col. 7 lines 57-60).

69. With respect to Claim 66, Duphorne teaches all the limitations of Claim 52 and further teaches said displaying means comprises an audio broadcasting device (Col. 7 lines 48-60).

70. With respect to Claim 67, Duphorne teaches all the limitations of Claim 52 and further teaches a filtering device for suspending said transmission signal corresponding

with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

71. With respect to Claim 68, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a filtering device for transferring said transmission signal corresponding with a plurality of set permission conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

72. With respect to Claim 70, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a connecting device for connecting said receiving terminal and electronic mail provider when said transmission signal is received (Col. 7 lines 11-26).

Claim Rejections - 35 USC § 103

73. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

74. Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,933,478 by Ozaki et al. (Ozaki).

75. With respect to Claim 3, Duphorne teaches all the limitations of Claim 1 and but does not explicitly disclose suspending a connection between the mail provider and receiving terminal by detecting a first deadline of establishing said connection. Ozaki

teaches that a connection between electronic mail provider and the receiving terminal is suspended by detecting a first deadline of establishing said connection (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises suspending a connection between said electronic mail provider and said receiving terminal by detecting a first deadline of establishing said connection. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28).

76. With respect to Claim 4, Duphorne in view of Ozaki teaches all the limitations of Claim 3 and further teaches reestablishing a connection between said electronic mail provider and said receiving terminal by detecting a first deadline of establishing said connection (Col. 12 lines 40-56).

77. With respect to Claim 13, Duphorne teaches all the limitations of Claim 1 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44).

Art Unit: 2155

78. With respect to Claim 14, Duphorne in view of Ozaki teaches all the limitations of Claim 13 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30).

79. With respect to Claim 28, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44).

80. With respect to Claim 29, Duphorne in view of Ozaki teaches all the limitations of Claim 28 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30).

81. With respect to Claim 48, Duphorne teaches all the limitations of Claim 40 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44).

Art Unit: 2155

82. With respect to Claim 49, Duphorne in view of Ozaki teaches all the limitations of Claim 48 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30).

83. With respect to Claim 59, Duphorne teaches all the limitations of Claim 52 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44).

84. With respect to Claim 60, Duphorne in view of Ozaki teaches all the limitations of Claim 59 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30).

85. With respect to Claim 71, Duphorne teaches a method for transferring an identification information of an electronic mail (Col. 2 lines 18-35), said method comprising: transferring said identification information from an electronic mail provider to an receiving terminal which is predetermined by a corresponding user of said electronic mail (Col. 4 lines 20-31); transferring an identification information of said electronic mail to said receiving terminal when a response message from said receiving terminal is received within a predetermined period (Col. 4 lines 20-31). Duphorne does not explicitly disclose suspending a connection if no response is received after a

Art Unit: 2155

predetermined period. Ozaki teaches that a connection between electronic mail provider and the receiving terminal is suspended when no response is received after a predetermined period (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises suspending a connection between said electronic mail provider and said receiving terminal when no said response message is received within said predetermined period. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28).

86. With respect to Claim 72, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches reestablishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period (Col. 12 lines 40-56 of Duphorne).

87. With respect to Claim 73, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said user connecting to said electronic mail provider for getting said electronic mail after receiving said identification information (Col. 7 lines 27-29 of Duphorne).

88. With respect to Claim 74, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of storing said identification information on said receiving terminal for displaying when said user queries (Col. 8 lines 8-28 of Duphorne).

Art Unit: 2155

89. With respect to Claim 75, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47 of Duphorne).

90. With respect to Claim 76, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67 of Duphorne).

91. With respect to Claim 77, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67 of Duphorne).

92. With respect to Claim 78, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33 of Duphorne).

93. With respect to Claim 79, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33 of Duphorne).

94. With respect to Claim 80, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a distinctive code (Col. 9 lines 23-30 of Ozaki).

95. With respect to Claim 81, Duphorne in view of Ozaki teaches all the limitations of Claim 80 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

Art Unit: 2155

96. With respect to Claim 82, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches hardware of said receiving terminal has a caller identification function (Col. 8 line 38-41 of Duphorne).

97. With respect to Claim 83, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said receiving terminal further comprises a connecting device for establishing a connection between said receiving terminal and said electronic mail provider (Col. 7 lines 11-26).

98. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,875,234 by Clayton et al. (Clayton).

99. With respect to Claim 17, Duphorne teaches all the limitations of Claim 1. Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

100. With respect to Claim 32, Duphorne teaches all the limitations of Claim 20. Although Duphorne teaches the transmission format is of an appropriate format for the

email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

101. Claims 39 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent Application Publication 2001/0012286 by Huna et al. (Huna).

102. With respect to Claim 39, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose a switch device for controlling operation of the receiving terminal. Huna teaches a switch device for controlling the receiving terminal such that transmission signals concerning new email are received when it is on and not received when it is off (Page 6 [0071]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Huna such that there is a switch device for controlling operation of said receiving terminal, said receiving terminal receiving said transmission signal when said switch device is in a on state, and said receiving terminal stopping receiving said transmission signal when said switch device is in an off state. One would

Art Unit: 2155

be motivated to have this as it allows the user to configure the notification system according to their current preference (Page 6 [0071]).

103. With respect to Claim 69, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose a switch device for controlling operation of the receiving terminal. Huna teaches a switch device for controlling the receiving terminal such that transmission signals concerning new email are received when it is on and not received when it is off (Page 6 [0071]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Huna such that there is a switch device for controlling operation of said receiving terminal, said receiving terminal receiving said transmission signal when said switch device is on, and said receiving terminal stopping receiving said transmission signal when said switch device is off. One would be motivated to have this as it allows the user to configure the notification system according to their current preference (Page 6 [0071]).

Conclusion

104. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

105. U.S. Patent 6,532,489 by Merchant "Electronic mail alerting system and method with user options." March 11, 2003. Sends identification information of a new email to a device that is independent from the user's normal log-in device.

Art Unit: 2155

106. U.S. Patent 6,094,477 by Nada et al. "Electronic mail terminal and system for automatically downloading electronic mail" July 25, 2000. Describes a system for downloading email or email information to a terminal making use of caller ID functionality.

107. U.S. Patent 6,052,442 by Cooper et al. "Internet answering machine" April 18, 2000. An Internet answering machine can periodically check an email server for new email and download at least a portion of email messages that have been received.

108. U.S. Patent 5,781,857 by Hwang et al. "Method of establishing an email monitor responsive to wireless communication system user" July 14, 1998. Monitors for new emails and notifies the user through a wireless communication system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2155

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David Lazaro
March 22, 2004



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